

### **REMARKS**

Reconsideration and withdrawal of the rejections of the pending claims are respectfully requested in view of the amendments and remarks herein, which place the application in condition for allowance.

#### **I. STATUS OF CLAIMS AND FORMAL MATTERS**

Claims 26-29, 33, 35, and 37-40 are pending in this application. Claims 26, 33, and 37 have been amended for clarity according to the Examiner's suggestions and to further define the claimed formulations. Claim 35 and 38-40 have been withdrawn although Applicants believe that claims 35 and 38-40 should be included in the examination or should be rejoined when the examined claims are allowed. No new matter has been added.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. §112. It is submitted that the amendments of the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

The issues raised by the Examiner in the Office Action are addressed below in the order they appear in the prior Action.

#### **II. THE REJECTIONS UNDER 35 U.S.C. §112 ARE OVERCOME**

Claims 26-29, 33, and 37 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The rejection is respectfully traversed.

Claims 26, 33, and 37 have been amended as suggested by the Examiner thereby obviating a rejection.

Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. §112, second paragraph, are respectfully requested.

#### **III. THE 35 U.S.C. §103 REJECTION IS OVERCOME**

Claims 26-29, 33 and 37 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Alig *et al.* ( U.S. Patent No. 6,518,296) in view of Cleverly *et al.* and Stetter *et al.* The rejection is respectfully traversed.

The Examiner is respectfully directed to the case law, namely, that there must be some prior art teaching which would have provided the necessary incentive or motivation for modifying the reference teachings. *In re Laskowski*, 12 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); *In re Obukowicz*, 27 U.S.P.Q. 2d 1063 (BOPAI 1993). Although a teaching, suggestion, or motivation to combine is no longer rigidly required for a finding of obviousness, it remains the primary guarantor against a non-statutory hindsight analysis. *Ortho-McNeil Pharm., Inc. v. Mylan Labs., Inc.*, 520 F.3d 1358, 1365 (Fed. Cir. 2008). Further, as stated by the Court in *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783-1784 (Fed. Cir. 1992): “The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification.” The requirement that For the §103 rejection to be proper, both the suggestion of the claimed invention and the expectation of success must be founded in the prior art, and not Applicant’s disclosure. *In re Dow*, 5 U.S.P.Q.2d 1529, 1531 (Fed.Cir. 1988).

Furthermore, the Supreme Court has recently reaffirmed the factors set out in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18: “[T]he scope and content of the prior art are determined; differences between the prior art and the claims at issue are...ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727.

Neither Alig *et al.* in view of Cleverly *et al.* and Stetter *et al.*, alone or in combination teach or suggest a premix formulation disclosed in claims 26 and 33 as amended. Neither Alig *et al.* in view of Cleverly *et al.* and Stetter *et al.*, alone or in combination teach or suggest the specific proportions of the ingredients of the claimed formulations as recited in claim 26 as amended. Neither Alig *et al.* in view of Cleverly *et al.* and Stetter *et al.*, alone or in combination teach or suggest the organic solvents of claim 33 in premix formulations of thioamide derivatives of 1-arylpyrazoles of the pending claims.

The present invention is inventive as Applicants surprisingly discovered that blood plasma levels of fipronil were higher when dogs were administered the oral formulation of the thioamide of fipronil compared with the administration of fipronil itself (see, e.g., Example 3 on page 85 of the specification as originally filed). This demonstrates that the thioamide derivative of fipronil degrades into fipronil in vivo in amounts that are sufficient for efficacy. None of the cited references alone or in combination relate to such efficacy of the presently claimed formulations.

For the foregoing reasons, the references cited by the Examiner do not render the claimed subject matter *prima facie* obvious. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. §103(a) are respectfully requested.

#### **IV. THE DOUBLE PATENTING REJECTION IS OVERCOME**

Claims 26-29 and 33 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1, 4, 5, 8-10, 13, 15-21, 23-29 and 33 or copending application no. 11/580,731.

The issue of whether there is indeed double patenting is contingent upon whether the remarks herewith are indeed considered and entered; and, if so, whether the Examiner believes there is overlap with claims ultimately allowed in the application. If, upon agreement as to allowable subject matter, it is believed that there is still a double patenting issue, a Terminal Disclaimer as to U.S. patent application no. 11/580,731 will be filed for the purposes of expediting prosecution.

Accordingly, reconsideration and withdrawal of the double patenting rejection, or at least holding it in abeyance until agreement is reached as to allowable subject matter, is respectfully requested.